

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHUJI NARAHARA, SHINJI KATSUYAMA, and NAOYUKI MATSUDA

Appeal No. 1998-3410
Application No. 08/444,062

HEARD: February 8, 2001¹

Before THOMAS, LALL, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-6, which are all of the claims pending in this application.

We REVERSE.

¹At the hearing, the panel indicated the intent to reverse the examiner's rejection. Therefore, appellants' representative made no further argument.

BACKGROUND

The appellants' invention relates to a printing apparatus for facsimile, copying and printing having automatic switching between first and second modes. The system automatically switches from a second mode (interrupt inhibit) to first mode (printing is effectuated with priority over facsimile printing/processing). An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A printing apparatus comprising:

first data receiving means for receiving a reception request signal and first print data which are transmitted through a first line;

second data receiving means for receiving second print data that are transmitted through a second line different from said first line;

printing means for printing each of the first and second print data on a medium;

mode setting means for selectively setting a first mode in which when said first data receiving means receives the reception request signal and said printing means prints the second print data received by said second data receiving means, the printing operation of said second data is interrupted, thereby allowing said printing means to execute a printing operation of the first print data from said first data receiving means in accordance with said reception request signal, and a second mode in which when said first data receiving means receives said reception request signal and said printing means prints the second print data received by said second data receiving means, said reception request is reserved, thereby allowing said printing means to continue the printing operation of said second data; and

control means for performing a control operation, such that when said second mode is set, said mode setting means automatically switches from said second mode to said first mode after completion of the printing of the second data.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Paradise	4,947,345	Aug. 07, 1990
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Claims 1-6 stand rejected under 35 U.S.C. § 102 as being anticipated by Paradise.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 13, mailed Dec. 11, 1997) for the examiner's reasoning in support of the rejection, and to the appellants' brief (Paper No. 12, filed Jul. 8, 1997) and reply brief (Paper No. 14, filed Feb. 10, 1998) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Appellants argue that the teachings of Paradise fail to suggest the specific elements and fail to provide any suggestion to modify the Paradise disclosure. (See brief

at page 5.) We agree with appellants that Paradise does not teach all the elements of the claimed invention. We do not reach the issue of whether Paradise suggests the claimed invention or modification thereof since the sole rejection is based upon anticipation.

Appellants state that arguably the third and second modes of Paradise correspond to the first and second modes of the claimed invention, but Paradise lacks the automatic mode switching feature of the claimed invention. (See brief at page 7.) We agree with appellants. Appellants argue that the first mode of Paradise (Automatic Fax Release Mode) treats print, copy and fax jobs in a first-in-first-out basis which cannot correspond to either appellants' first or second modes. We agree with appellants.

The examiner maintains the Paradise teaches the claimed invention and refers generally to columns 5 and 6 along with figure 11. Further, the examiner states that "Paradise et al. clearly suggests that once there are fax jobs in the hold queue during automatic fax release mode, the printing system return[s] to execute any fax job

requests received, otherwise [it] process [sic, processes] any [other] fax jobs requests."

(See answer at page 6.) We disagree with the examiner's statement in the rejection.

It is well established that the prior art reference need not expressly disclose each claimed element in order to anticipate the claimed invention. **See Tyler Refrigeration v. Kysor Indus. Corp.**, 777 F.2d 687, 689, 227 USPQ 845, 846-847 (Fed. Cir. 1985).

Rather, if a claimed element (or elements) is inherent in a prior art reference, then that element (or elements) is disclosed for purposes of finding anticipation. **See Verdegaal Bros., Inc. v. Union Oil Co.**, 814 F.2d at 631-33, 2 USPQ2d at 1052-54.

It is well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office (PTO). **See In re Piasecki**, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). When relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. **See Ex parte Levy**, 17 USPQ2d 1461, 1464 (Bd. Patent App. & Int. 1990).

Here, the examiner's statement that the reference "clearly suggests . . ." does not rise to the level of inherency. Furthermore, the claimed automatic mode switching does not necessarily flow from the teachings of Paradise. The examiner goes further to maintain that "the means for detecting an end of the computer data printing process reads on the function of the queue management system to detect the end of a printing job in order to automatically return[s] to the fax release mode giving priority to the fax jobs (columns 5

and 6).” (See answer at page 7.) We disagree with the examiner’s conclusion and broad sweeping citations to the same portion of the specification without specifically identifying the support or reasoning for the conclusion.

In response to appellants' arguments, the examiner relies upon column 6, lines 4-7 where Paradise states that “fax jobs may be released individually in which case the released fax jobs are individually inserted into the output queue 310 ahead of the next print or copy job scheduled to be printed.” The examiner maintains that “once the fax jobs are performed the queue management system return[s] to print the copy and print jobs . . . [t]hereby changing the mode of the system between fax jobs and copy/print jobs.” (See answer at page 8.) The examiner relies upon the statement in Paradise that “[p]rint, copy, and fax jobs 300, 303, 305 may be moved into output queue 310 at any time.” Appellants argue that nowhere does Paradise teach that the system automatically switches from the second mode to the first mode in response to completion of a printing of fax job or completion of a second mode print. (See reply

brief at page 1.) We agree with appellants. Appellants argue that the examiner is equating the changing of the order of printing with a change in the modes. (See reply brief at page 2.) We agree with appellants that this appears to be the examiner’s position. Further, we agree with appellants that the changing of the order of prints is not the same as

changing the mode of operation. Appellants argue that the triggering event for a change from the hold fax mode of Paradise to the released fax mode is because the holding queue becomes filled, not because there has been a completion of the printing of a print/copy job as required by the language of claim 1. (See brief at page 9 and reply brief at page 2.) Appellants argue that Paradise does not disclose the triggering events for changes in modes of operation. (See brief at page 9.) We agree with appellants that Paradise is not detailed as to the interaction of the modes. (See brief at page 9 and 10.) Since Paradise does not disclose, either expressly or inherently, the operation of the interaction of the modes to be automatic switching as recited in the language of claim 1, we cannot sustain the examiner's rejection based upon anticipation. Similarly, independent claims 2 and 3 along with dependent claims 4-6 are not taught by Paradise alone.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-6 under 35 U.S.C. § 102 is reversed.

Appeal No. 1998-3410
Application No. 08/444,062

REVERSED

JAMES D. THOMAS
Administrative Patent Judge

PARSHOTAM S. LALL
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

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